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09/194,051 03/25/99 SUGIYAMA A 051508/0103

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EXAMINER

HEWITT, C

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

01/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/194,051

Applicant(s)

SUGIYAMA, AKIRA

Examiner

Calvin L Hewitt II

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 14 and 16-22 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-39 have been examined.

***Claim Objections***

2. Claims 14 and 16-22 are objected to because of the following informalities:  
numerous spelling errors- "mater", "host compute" and "thicket". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 13-22, 25-35 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-10, 13-22, 25-35 and 37, they are narrative in structure and are replete with functional language. The claim structure and/or lexicon clutters the intent of

the Applicant regarding the scope of the invention, therefore, the claims fail to provide one of ordinary skill in the art with the proper infringement parameters. With regard to specific terminology, the use of terms such as, “additional data”, “various information”, “on the basis of” and “such a way” are vague and do not specifically describe the invention. Claims 6, 7 and 14-22 are particularly problematic as they depict functions that can be performed by a plurality of means and again do not provide one of ordinary skill in the art with appropriate operating constraints. For example, claim 14 cites, “ a host computer of a central bank exercising general control of banking operations and said subservient computers are computers of banking agencies such as city, local and credit banks under control of the host computer of the central bank... ”.

Regarding claims 14-16, 18 and 22, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

As per claims 4, 32-35 and 37, the Applicant is defining these claims in terms of what it is not rather than what it is. In particular, these claims use the terms “peculiar” (page 58, line 22) and “similar” (pages 14, line 12 and 75, line 12) which are indefinite (see MPEP page 2100-148, section 2173.05(b)-C). Therefore the Examiner regards these claims as unclear. This rejection also applies to claims 33-35 and 37 as they are dependent on claim 32.

The method and system that define an invention must be clearly and positively specified. Further, the claims must be presented in an organized and correlated manner

as to present a complete operative invention. As a suggestion, the Examiner would like to direct the Applicant to the patents cited in this Office Action, in particular Brandt et al. U.S. Patent No. 6,125,384 to serve as a template for appropriate claim structure and language.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,933,625 in view of Ishiguro et al., U.S. Patent No. 5,502,765 and Examiner's Official Notice.

As per claims 1-39, the Applicant in U.S. Patent No. 5,933,625 claims a unique time generating device that:

- sequentially outputs unit time values at predetermined intervals over a preset time measuring period with given start and end points (claim 1- column/line 23/45-24/11)
- accumulates time values over the time-measuring period (claim 1- column 24, lines 3-7)
- provides for the communication between a plurality of computers of data based on timer signals (claims 5 and 6- column 24, lines 23-39)
- provides a master and subordinate processing environment (claims 6 and 7, column 24, lines 36-45)

The Applicant in U.S. Patent No. 5,933,625 does not teach of "time" renewal in claims 1-7. But, the Applicant does teach of time data being accumulated over a "pre-set time measuring period" and a timer that generates "periodic timer signals". Hence, it would have been obvious to apply "time" renewal means to the system and store these renewals in the system in order to further the life of the system and facilitate transactions whose life cycle extends beyond the initial fixed time period.

However, the claims do not teach of registering means, appending new data to existing data, IC cards and IC card applications, card verification, data collation, data updates and storage of time data. Ishiguro et al. disclose an IC card settlement method with a system of management, terminal and dispenser computers that provide for:

- appending new data to existing data (column 13, lines 47-55; column 26, lines 11-24)
- registration means (column 13, lines 51-55; column 14, lines 3-5; column 15, lines 37-40; column 16, lines 7-10)
- IC cards and IC card applications (figure 1; column 1, lines 11-67; column/line 5-42-6/13; column 8, line 33-47; column 20, lines 10-29)
- IC card storage (column 9, lines 6-21; column/line 16/58-17/16)
- card verification, validation and invalidation (column/line 7/60-8/23; column 8, lines 48-51; column 9, lines 6-22; column 14, lines 3-25; column/line 17/60-18/2)
- time-data and data collation (column/line 7/60-8/23; column 8, lines 48-51; column 9, lines 6-22; column 16, lines 1-10; column 17, lines 5-16)
- (sequential) time data updates and storage (column 15, lines 37-63; column 16, 1-10)

- using time data to authorize cards (column/line 15/54-16/10; column/line 17/5-18/2; column 25, lines 50-53)
- input/output devices (column/line 5/65-6/6)
- data unique to a computer and card (column 15, lines 28-67; column 25, lines 45-54)

In addition, Ishiguro et al. apply their system to remote computers in a communication link with a management center (figure 1; column 5, lines 42-64; column 7, lines 51-59; column 11, lines 3-11; column 13, lines 48-54; column 14, lines 3-8; column 15, lines 54-60; column 20, lines 10-29; column 25, lines 28-63; column 26, lines 3-10). As well as local computers possessing the authorization functionality of a management computer (column 20, lines 10-29; column 24, lines 19-39; column 26, lines 10-24). Distributive business systems are well known and widely used. It is also well known that the reduction in computing costs and the increase in processing speed has lead to a paradigm shift away from mainframes. Hence firms have increased the functionality of remote computers as well as the physical distance between these computers and the firms central or main computer. In other words, the role played by these remote or local computers in terms of executing a firm's objectives has become primarily a matter of design as the technology exists to support most enterprise models. Further, it would have been obvious to have the system's central, main, supervisor, managerial... etc. computer to take on the role of "official time-keeper". As the central



computer serves as the controller and primary processing reference for a plurality of subordinate computers (figure 1), all other computers should be synchronized in accordance with the managerial computer (figure 1) in order to maintain system integrity.

However, neither the Applicant in claims 1-7 of U.S. Patent No. 5,933,625 nor Ishiguro et al. detail the system in terms of specific commerce applications of an IC or smart card. While Ishiguro et al. mention pre-paid cards (column 15, lines 9-11) and telephone controllers (column 15, lines 16-19) for example, absent are the business systems that support these and other IC card functions. Hence, the Examiner takes Official Notice that IC or smart cards that are used in electronic money applications or monetary transactions and that interact with gaming, banking or travel computers systems are well known in the art of online or offline electronic commerce. Therefore, it would have been obvious to combine the Applicant's teachings with those of Ishiguro et al.

In claims 5 and 6 of U.S. Patent No. 5,933,625, the Applicant details a system where computers communicate using unique time data. While Ishiguro et al. disclose an IC card verification system where computers exchange data via a communication network (column 5, lines 41-64). Ishiguro et al. also provide a system where card validation is conducted over said network using time stamp data (column/line 15/12-18/26). Note Ishiguro et al. do not specify nor does their verification approach rely upon any particular time keeping method. Therefore, their method for account settlement via IC cards is time keeping method independent and would work equally well whether

using Greenwich time or the “unique” time approach put forth by the Applicant (U.S. Patent No. 5,933,625).

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Brandt et al. teach a computer apparatus and method for communicating between software applications and computers via the world wide web
- Nakamura et al. disclose a system and method for revaluation of stored tokens in IC cards
- Ohashi et al. teach an authentication system

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 305-0625. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

January 2, 2001



**JAMES P. TRAMMELL**  
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